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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,698	01/23/2002	Tatsuki Shiota	Q68142	8252

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,698

Applicant(s)

SHIOTA ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted May 25, 2006 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (WO 0031032, IDS 02/23/2005), in view of Chen et al. (IDS 12/22/2004).

3. Rogers teaches pyrrolidine derivatives-CCR-3 receptor antagonist with a general formula I, wherein Z may be N, A may be -NCO-, B is alkylene with 1-4 carbon inclusive wherein one of the carbon atom may optionally be replaced by -N(R4)-, Ar1 and Ar 1 may be aromatic or heteroaromatic rings, including naphthyl group, which are meet the all the limitation herein defined except that n, as herein defined is 1, and the claimed compounds require n is 0. See pages 3-4, and 7. Those compounds are disclosed as useful pharmaceutical agent for treating CCR-3 receptor associated disorders, particularly, those eosinophil-mediated inflammatory diseases. See, the abstract, and pages 1-2, and the claims.

4. Rogers does not teach expressly the employment of the particular compound herein treating the eosinophilic disorders herein.

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However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use the compounds herein as CCR-3 receptor antagonist for treating the eosinophilic disorders herein.

A person of ordinary skill in the art would have been motivated to use the compounds herein as CCR-3 receptor antagonist for treating the eosinophilic disorders herein. Because the instant compounds are structural homologs of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. In re Hass, 60 USPQ 544 (CCPA 1944); In re Henze, 85 USPQ 261 (CCPA 1950).

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (WO 0031032, IDS 02/23/2005), for reasons as set forth above, and in further view of Chen et al. (IDS 12/22/2004).

6. Rogers does not teach expressly the employment of CCR-3 receptor antagonist for treating AIDS.

7. However, Chen et al. teaches that CCR3 is a co-receptors for HIV-1 infection of microglia. The receptor promotes the efficient infection by HIV in CNS. See, particularly the abstract.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use CCR3 receptor antagonist herein for treating AIDS patients

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A person of ordinary skill in the art would have been motivated to use CCR3 receptor antagonist herein for treating AIDS patients because CCR3 antagonist would have been reasonably expected to slow the infection by HIV in CNS.

Response to the Arguments

Applicants' amendments and remarks submitted May 25, 2006 have been fully considered, but are not persuasive with respect to the rejections set forth above.

Applicants contend that the claimed invention would have not been obvious over Rogers et al. since Rogers et al. do not actually prepared the compound employed herein. The arguments are untenable. It is well-settled that "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Rogers et al. particularly teach that the Ar in formula (I) may be aryl or heteroaryl group. Note naphthyl group has been particularly mentioned. (page 7, lines 25-27).

US 6,164,015 listed in form 892 attached is a US equivalent of Rogers et al. WO00/31032 cited herein.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER
Shengjun Wang
Primary Examiner
Art Unit 1617